

REMARKS

Reconsideration of the election of species requirement is respectfully requested. The Applicant respectfully traverses the election of species requirement for the reasons set out below.

Referring to the Office Action, the Examiner states that the Application contains claims directed to the following patentably distinct species:

Specie I - apparatus with underlying and overlying surfaces and no axially movable member and bore engaging elements integrally formed with carriage assembly (embodiment of Figures 20-24);

Specie II - apparatus with no underlying and overlying surfaces and no axially movable member and different assembly housing sizes (embodiment of Figures 25-29);

Specie III - apparatus with underlying and overlying surfaces and no axially movable member (embodiment of Figures 30-32); and

Specie IV - apparatus with no underlying and overlying surfaces and no axially movable member with single assembly housing size (embodiment of Figures 33-42).

The species are indicated to be "independent or distinct because not all embodiments include underlying and overlying surfaces and have varying assembly housing sizes."

In identifying the Species of the Invention, it appears that the Examiner may have made an error as the preferred embodiment of the Invention, shown in Figures 1 - 19, has not been identified as one of the species available for election by the Applicant. Further, the features of the preferred embodiment of the Invention are not included in the description of the features provided for any of the four Species identified by the Examiner. In other words, as identified by the Examiner, it is impossible for the Applicant to elect a species including the preferred embodiment.

As a result, in reply to the election requirement, it is respectfully submitted that the present Application describes five embodiments of the Applicant's Invention, as set out in the "Brief Description of Drawings" contained on Page 18, line 26 - Page 22, line 32 as follows:

- (a) Figures 1 - 19 - show "a preferred embodiment" of the Invention, which includes the underlying and overlying surfaces and the axially movable member;
- (b) Figures 20 - 24 - show "a first alternate embodiment" of the Invention, which includes underlying and overlying surfaces but does not include the axially movable member (Species I of the Examiner);
- (c) Figures 25 - 29 - show "a second alternate embodiment" of the Invention, which does not include underlying and overlying surfaces and does not include the axially movable member (Species II of the Examiner);
- (d) Figures 30 - 32 - show "a third alternate embodiment" of the Invention, which includes underlying and overlying surfaces and does not include the axially movable member (Species III of the Examiner); and
- (e) Figures 33 - 42 - show "a fourth alternate embodiment" of the Invention, which does not include underlying and overlying surfaces and does not include the axially movable member (Species IV of the Examiner).

With respect to Species IV, it is further respectfully submitted that the Examiner's characterization of Species IV is incorrect, in that Figures 33 - 42 are not directed at "a single assembly housing size." Rather, as stated at Page 50, lines 20 - 30 of the Application, each of the alternate embodiments is substantially similar to the preferred embodiment except as stated to the contrary.

In this Application, each embodiment of the variable gauge drilling apparatus (20) includes an assembly housing (60) having an assembly housing size and defining a device size. The assembly housing size is variable such that the device may be

provided with differing device sizes. The device size of the device (20) shown in Figures 33 - 42 is variable, although Figure 39 shows a first drilling apparatus size (220) only. Thus, a single assembly housing size is shown in these Figures. However, the assembly housing (60) of the device (20) is removable and replaceable with an alternate assembly housing (60), having an alternate assembly housing size, where a different device size is desired. (Refer to the Application at: Page 23, lines 4 - 14; Page 23, line 23 - Page 24, line 27; Page 33, lines 4 - 18; and Page 57, lines 1 - Page 60, line 12).

As the Applicant wishes to elect the "preferred embodiment" of the Invention for further examination at this time, the Applicant provisionally elects the species of Figures 1 - 19.

Further, it is respectfully submitted that all of the presently pending Claims of the Application are either "generic" claims or the Claims read on or are directed at the preferred embodiment of the Invention as shown in Figures 1 - 19.

Specifically, apparatus Claims 1 - 33 and method Claims 34 - 38 are presently pending. It is respectfully submitted that the Claims may be classified as follows:

- (a) Generic Claims - apparatus Claims 1 - 12 and method Claims 34 - 38 are "generic" in nature, in that they relate to or read on all five embodiments of the Invention shown in Figures 1 - 42.

Although the Examiner states that Claims 13 - 14 are also "generic", these Claims only relate to 3 of the 5 embodiments of the Applicant's Invention. Specifically, apparatus Claims 13 - 14 are directed at the underlying and overlying surfaces. Thus, these Claims are directed at the preferred embodiment, Species I and Species III as set out above;

- (b) Preferred Embodiment (Figures 1 - 19) - apparatus Claims 13 - 33 are all directed at, and read on, the preferred embodiment of the Applicant's Invention. Of these Claims, Claim 15 is directed at the axially movable member. Claims 16 - 33 all

depend directly or indirectly from Claim 15. Thus, Claims 15 - 33 are directed at and read on the preferred embodiment of the Invention shown in Figures 1 - 19 only;

- (c) Species I (Figures 20 - 24) - Claims 13 - 14 are also directed at and read on Species I, which includes the underlying and overlying surfaces;
- (d) Species II (Figures 25 - 29) - no additional apparatus claims are directed at or read on Species II;
- (e) Species III (Figures 30 - 32) - Claims 13 - 14 are also directed at and read on Species III, which includes the underlying and overlying surfaces; and
- (f) Species IV (Figures 33 - 42) - no additional apparatus claims are directed at or read on Species IV.

In summary, the Applicant provisionally elects the species of the Invention shown in Figures 1 - 19, being the preferred embodiment of the Applicant's Invention. In addition, it is respectfully submitted that generic apparatus Claims 1 - 12 and generic method Claims 34 - 38 are readable on the species of the embodiment of Figures 1 - 19. Further, it is respectfully submitted that apparatus Claims 13 - 33 are also readable on the species of the embodiment of Figures 1 - 19.

Thus, it is submitted that all of Claims 1 - 38 should be examined in accordance with the Applicant's election of the species of the embodiment shown in Figures 1 - 19 of the Application.

In any event, the Applicant respectfully further traverses the election of species requirement on the basis that all of the five embodiments of the Applicant's Invention are so interrelated that a search and examination of the species of the preferred embodiment would probably overlap or encompass the search field of the remaining species of the alternate embodiments.

More particularly, the claims directed at the preferred embodiment include underlying and overlying surfaces and an axially movable member. The four alternate embodiments include many of the same features of the preferred embodiment, as evidenced by the number of generic claims in the Application. Species I and III include the underlying and overlying surfaces of the preferred embodiment. Species II and IV do not include the underlying and overlying surfaces or the axially movable member. However, only the generic Claims of the Application are directed at Species II and IV.

It is thus submitted that a simultaneous search directed at all of the Claims can be made without substantial increase of the search effort and without a serious burden on the Examiner (MPEP Sections 803 and 808.02).

Withdrawal of the Election of Species Requirement and the examination of all Claims in this Application are respectfully requested.

Respectfully submitted,

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